

## **REMARKS**

Applicants have amended claims 22 and 24, and have cancelled claims 1-21 and 23, during prosecution of this patent application. Applicants are not conceding in this patent application that the subject matter encompassed by said amended and cancelled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicants respectfully reserve the right to pursue the subject matter encompassed by said amended and cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

The subject matter recited in new claims 26, 31, and 46 (“wherein the contract does not encompass the technical model and the technical framework”) is supported in the originally filed specification, page 22, lines 9-10.

The subject matter recited in new claims 27, 32, and 47 (“wherein the method further comprises: delivering the specific set of information technology services to the customer, said delivering requiring combinations of points-of-control due to contractual, geographical, linguistic, and chronological requirements”) is supported in the originally filed specification, page 22, line 23 - page 23, line 1.

The subject matter recited in new claims 28, 33, and 48 (“wherein the method further comprises: reducing an architecture complexity and infrastructure costs while supporting continuous improvement by remaining flexible enough to use new technologies, reducing training and staffing costs, reducing system integration costs, and allowing an outsourcing entity to provide service to any customer set, regardless of size, geography, language, nature of the

customer's business, and technology or scope of management services required") is supported in the originally filed specification, page 23, lines 11-17.

The subject matter recited in new claims 29, 34, and 49 ("wherein each building block is independent of an underlying physical implementation") is supported in the originally filed specification, page 24, lines 13-14.

The subject matter recited in new claims 30, 35, and 50 ("wherein the contract has a scope, and wherein the customer's exiting equipment that is mapped consists of each piece of equipment that is within the scope of the contract-") is supported in the originally filed specification, page 32, lines 8-9.

The Examiner rejected claims 22, 24 and 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner rejected claims 22, 24 and 25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Allen et al. (International Application under PCT, WO 01/15003) in view of Mikurak (US Patent No. 6,671,818).

Applicants respectfully traverse the § 112 and § 103 rejections with the following arguments.

**35 U.S.C. § 112, Second Paragraph: Claims 22, 24 and 25**

The Examiner rejected claims 22, 24 and 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Firstly**

The Examiner argues: “Firstly, on line 10 of claim 22 for example, it recites “to deliver specific services to customers...”. It is unclear if this “customer” is the same as the “customer” on line 8 of the claim. Similarly on line 2, 5, and 17. If these occurrences of the limitation “customer” is intended to refer to the same, then the limitations appear contradictory. If they are not the same then the limitations are unclear and are indefinite.”

In response, Applicants respectfully contend that “the customer” in lines 5 and 17 of claim 22 has antecedent basis in “a customer” in line 2 of claim 22. Therefore, “the customer” in lines 5 and 17, and “a customer” in line 2 of claim 22, are consistent and proper.

In further response, Applicants respectfully contend that “customers” in line 10 of claim 22 does not have antecedent basis in “a customer” in line 2 of claim 22, and thus is not referring to “a customer” in line 2 of claim 22, which is further supported as follows: (i) “customers” in line 10 is not preceded by “the”; and (ii) “customers” is plural, whereas “a customer is singular”. Therefore, “customers” in line 10 of claim 22 is clear and not indefinite.

Applicants note that in the office action mailed 11/30/2005, the Examiner did not reject “customers” in claim 22 under 35 U.S.C. § 112, second paragraph and thus apparently considered “customers” in claim 22 (in the same claim language as the present claim 22) to be clear and not

indefinite.

Applicants note that in the office action mailed 07/27/2006, the Examiner did not reject “customers” in claim 22 under 35 U.S.C. § 112, second paragraph and thus apparently considered “customers” in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite.

Applicants note that in the office action mailed 01/11/2007, the Examiner did not reject “customers” in claim 22 under 35 U.S.C. § 112, second paragraph and thus apparently considered “customers” in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite.

Applicants note that in the Advisory Action mailed 09/22/2007, the Examiner did not express any lack of clarity of “customers” in claim 22 and thus apparently considered “customers” in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite.

Applicants note that in the Examiner’s Answer mailed 02/20/2007, the Examiner again did not express any lack of clarity of “customers” in claim 22 and thus apparently considered “customers” in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite.

Even the Board of Patent Appeals and Interferences had no difficulty in interpreting “customers” in claim 22 during the appeal.

Therefore, Applicants are puzzled as to why the Examiner presently alleges a lack of clarity as to “customers” in claim 22, after the Examiner found “customers” in claim 22 to be clear and not indefinite in the preceding five times when the Examiner analyzed claim 22, and

after the Board of Patent Appeals and Interferences had no difficulty in interpreting “customers” in claim 22 during the appeal.

## Secondly

The Examiner argues: “Secondly, the term “sufficiently” on line 11 of claim 22 for example, is a relative term which renders the claim indefinite. The term “sufficiently” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.”

In response, Applicants respectfully contend that the appearance of “essentially” in claims analogous to “essentially modular” in claim 22 is very commonly used and well accepted by the United States Patent and Trademark Office (USPTO).

On 03/31/2011, Applicants’ Representative (Jack P. Friedman) searched the USPTO database for the appearance of “essentially” in claims in issued patents and obtained 180,534 hits, including the following five exemplary patents issued on 03/29/2011 in which the specification does not state a requisite degree for “essentially” appearing the claims:

- (1) U.S. Patent 7,917,879 to Becker et al. (“essentially any two dimensional shape”);
- (2) U.S. Patent 7,917,366 to Levanon et al. (“essentially real time”);
- (3) U.S. Patent 7,917, 267 to Aigner et al. (“essentially constant distance”);
- (4) U.S. Patent 7,917,018 to Becker et al. (“an essentially transparent wall”);
- (5) U.S. Patent 7,916,915 to Gkanatsios et al. (“essentially immobilized”).

The preceding five issued patents is a very small sample of issued patents having claims

in which “essentially” appears such that the specification does not state a requisite degree for ‘essentially’ that appears in the claims, The actual number of such issued patents is huge.

Thus, the Examiner’s rejection of claim 22 under 35 U.S.C. § 112, second paragraph for use of “essentially modular” is contrary to established practice by the USPTO and has no basis in patent law.

Applicants note that in the office action mailed 11/30/2005, the Examiner did not reject claim 22 under 35 U.S.C. § 112, second paragraph for use of “essentially modular” and thus apparently considered “essentially modular” in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite.

Applicants note that in the office action mailed 07/27/2006, the Examiner did not reject claim 22 under 35 U.S.C. § 112, second paragraph for use of “essentially modular” and thus apparently considered “essentially modular” in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite.

Applicants note that in the office action mailed 01/11/2007, the Examiner did not reject claim 22 under 35 U.S.C. § 112, second paragraph for use of “essentially modular” and thus apparently considered “essentially modular” in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite” in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite.

Applicants note that in the Advisory Action mailed 09/22/2007, the Examiner did not express any lack of clarity of “essentially modular” in claim 22 and thus apparently considered “essentially modular” in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite.

Applicants note that in the Examiner's Answer mailed 02/20/2007, the Examiner again did not express any lack of clarity of "essentially modular" in claim 22 and thus apparently considered "essentially modular" in claim 22 (in the same claim language as the present claim 22) to be clear and not indefinite.

Even the Board of Patent Appeals and Interferences had no difficulty in interpreting "essentially modular" in claim 22 during the appeal.

Therefore, Applicants are puzzled as to why the Examiner presently alleges a lack of clarity as to "essentially modular" in claim 22, after the Examiner found "essentially modular" in claim 22 to be clear and not indefinite in the preceding five times when the Examiner analyzed claim 22, and after the Board of Patent Appeals and Interferences had no difficulty in interpreting "essentially modular" in claim 22 during the appeal.

Accordingly

Based on the preceding arguments, Applicants respectfully request withdrawal of the rejection of claims 22, 24 and 25 under 35 U.S.C. § 112, second paragraph.

**35 U.S.C. § 103(a): Claims 22, 24 and 25**

The Examiner rejected claims 22, 24 and 25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Allen et al. (International Application under PCT, WO 01/15003) in view of Mikurak (US Patent No. 6,671,818).

Applicants respectfully contend that claims 22, 24 and 25 are not unpatentable over Allen in view of Mikurak, because Allen in view of Mikurak does not teach or suggest each and every feature of claims 22, 24 and 25.

A first example of why claims 22, 24 and 25 are not unpatentable over Allen in view of Mikurak is that Allen in view of Mikurak does not teach or suggest the feature: “determining a solution scope for the technical framework to be created, ... the solution scope based on common practices for delivering certain types of information technology services”.

The Examiner argues: “Allen teaches ... determining a solution scope for the technical framework to be created, the solution scope based on common practices for delivering certain types of information technology services (page 3 line 11 – page 4 line 20, Allen discloses a Roadmap Program (i.e. "solution scope"))”.

In response, Applicants note that the Roadmap Program in Allen is a “programmed database interface tool” (Allen, page 4, lines 14-15) that “provides the necessary planning data for making these decisions such as the standard technology platforms being supported by the organization and the dependencies on other components” (Allen, page 4, lines 26-28). Thus Allen does not disclose that the Roadmap Program in Allen determines a solution scope based on common practices for delivering certain types of information technology services.



Therefore, Allen in view of Mikurak does not disclose the preceding feature of claims 22, 24 and 25.

A second example of why claims 22, 24 and 25 are not unpatentable over Allen in view of Mikurak is that Allen in view of Mikurak does not teach or suggest the feature: “the solution scope guided by an information technology services contract with the customer”.

The Examiner argues: “Allen fails to explicitly disclose “the solution scope guided by an information technology services contract with the customer”. However, Mikurak teaches a method of generating a contract between a software owner and a software user. This is for the purpose of creating a license agreement where it allows a vendor to maintain some control over the use of its product. (see Mikurak, at least figure 64 and column 114 lines 6-23). It would therefore be obvious to one of ordinary skill in the art to implement a service contract for the purpose of licensing.”

In response, Applicants respectfully contend that the alleged disclosure in Mikurak (of generating a contract between a software owner and a software user to create a license agreement allowing a vendor to maintain some control over the use of its product) does not disclose that the contract guides the solution scope (which the Examiner alleges to be the Roadmap Program in Allen).

Therefore, Allen in view of Mikurak does not disclose the preceding feature of claims 22, 24 and 25.

A third example of why claims 22, 24 and 25 are not unpatentable over Allen in view of

Mikurak is that Allen in view of Mikurak does not teach or suggest the feature: “mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities”.

The Examiner argues: “Allen teaches ... mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities (page 7 lines 25-30, Allen discloses components (i.e. "architectural building blocks"))”.

In response, Applicants note that Allen, page 7, lines 25-30 recites: “A Component is the basic building block of the technology infrastructure. Each type of hardware, software, product or service tracked by the system is defined as a Component. An example of a Component would be a "Workstation". The details maintained on each Component include the owner of the Component within the enterprise, the defined scope of the Component, projects registered with respect to the Component, dependencies”.

Given the Examiner’s allegation that “components” in Allen represent the claimed “architectural building blocks”, the preceding quote from Allen, page 7, lines 25-30 does not disclose the limitation of: mapping the customer's existing equipment to lowest level abstractions of components in a technical model.

Therefore, Allen in view of Mikurak does not disclose the preceding feature of claims 22,

24 and 25.

In addition, the Examiner argues: “Allen also fails to explicitly disclose "used to deliver specific services to customer". However, the Allen reference is regarding multi-disciplined organizations (page 1 lines 2-3) within the context of business and economy (page 1). "Official Notice" is taken that is obvious to one of ordinary skill in the art the multi-disciplined organizations can be used to deliver specific services to their clients/customers. Businesses and organizations are motivated by financial reasons to provide services to clients/customers.”

In response, Applicants respectfully contend that the preceding argument by the Examiner contains a serious logical error of analyzing "used to deliver specific services to customer" in isolation and not paying attention to the fact that the limitation at issue is “the technical model describing people, processes, tools and information used to deliver specific services to customers”, which the Examiner has ignored and which the cited prior art does not disclose.

The fact that multi-disciplined organizations can be used to deliver specific services to their clients/customers does not imply that “the technical model describing people, processes, tools and information used to deliver specific services to customers”, because multi-disciplined organizations cannot be equated with “the technical model describing people, processes, tools and information “.

Thus, the Examiner has thus failed to establish a *prima facie* case of obviousness in relation to claims 22, 24 and 25.

Therefore, Allen in view of Mikurak does not disclose the preceding feature of claims 22, 24 and 25.

A fourth example of why claims 22, 24 and 25 are not unpatentable over Allen in view of Mikurak is that Allen in view of Mikurak does not teach or suggest the feature: “creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components”.

The Examiner argues: “Allen teaches ... creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components (page 8 lines 2-6, Allen discloses streams (i.e. "design objects"))”.

In response, Applicants note that Allen, page 8, lines 2-6 recites: “A "Stream" is an alignment of Components into a logical group. For example, a Workstation Component might be aligned to a "Hardware" Stream. All Components in the central database are aligned under a particular Stream. Finally, each Stream in the database is aggregated into an Infrastructure Category, which is simply a logical group of Streams.”

Thus, the Examiner alleges that the claimed “design objects” are represented in Allen by streams of components in a central database. The Examiner also alleges that the claimed “solution scope” is represented by the Roadmap Program which is a programmed database interface tool.

Therefore, the Examiner is arguing that Allen, page 8, lines 2-6 discloses that a list of the streams of components is created as a function of the Roadmap Program, which does not make sense and which Allen does not disclose.

Therefore, Allen in view of Mikurak does not disclose the preceding feature of claims 22,

24 and 25.

A fifth example of why claims 22, 24 and 25 are not unpatentable over Allen in view of Mikurak is that Allen in view of Mikurak does not teach or suggest the feature: “designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer”.

The Examiner argues: “Allen teaches ... designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer (page 8 lines 13-20, Allen discloses dependencies (i.e. "relationships"))”.

In response, Applicants note that Allen, page 8, lines 11-20 recites: “The Roadmap Program provides a web-based interface and supports various web-based tools, which permit a User, depending on appropriate security access, to interact with the technology infrastructure details maintained in the central database. For a view of the entire technology infrastructure, a User can select the "Map" view of the program, which will display all the Components and Streams of the technology infrastructure, the dependencies between various Components, and other features as will be discussed in more detail below. A User seeking further details can select the "Component" view of the Roadmap program to see the details and planning information maintained on each component.”

Thus, the Examiner alleges that the claimed “relationships” are represented in Allen by the dependencies between various components. The Examiner also alleges that the claimed “design objects” are represented in Allen by steams of components in a central database. The Examiner also alleges that the claimed “solution scope” is represented by the Roadmap Program

which is a programmed database interface tool.

Therefore, the Examiner is arguing that Allen, page 8, lines 13-20 discloses designating dependencies between various components as a function of the Roadmap Program and the specific set of information technology services for the customer, which does not make sense and which Allen does not disclose.

Therefore, Allen in view of Mikurak does not disclose the preceding feature of claims 22, 24 and 25.

Based on the preceding arguments, Applicants respectfully maintain that claims 22, 24 and 25 are not unpatentable over Allen in view of Mikurak, and that claims 22, 24 and 25 are in condition for allowance.

## **CONCLUSION**

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM). The Attorney's reference number for this case is END-5433.

Date: April 1, 2011

/ Jack P. Friedman /  
Jack P. Friedman  
Registration No. 44,688

Customer No. 30449  
Schmeiser, Olsen & Watts  
22 Century Hill Drive - Suite 302  
Latham, New York 12110  
Telephone (518) 220-1850  
Facsimile (518) 220-1857  
E-mail: jfriedman@iplawusa.com